

REMARKS

Claims 1-11 were pending in this application.

Claims 1-11 have been rejected.

Claims 1, 3, 5, and 7-11 have been amended as shown above.

Claims 12-20 have been added.

Claims 1-20 are now pending in this application.

Reconsideration and full allowance of Claims 1-20 are respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. § 102

The Office Action rejects Claim 1 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,507,306 to Griesau et al. ("*Griesau*"). The Office Action rejects Claims 5-7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,962,992 to Huang et al. ("*Huang*"). These rejections are respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Griesau recites a universal remote control unit for controlling devices such as a cable box, a television, a video device, and an audio device. (*Abstract*). *Griesau* lacks any mention of

controlling multiple “lighting devices” using a remote control. In particular, *Griesau* lacks any mention of “associating ... each of the plural lighting devices with the remote control” and “associating ... each of the plural lighting devices ... with at least one of a particular function and a particular key on the remote control” as recited in Claim 1. As a result, *Griesau* fails to anticipate these elements of Claim 1.

For these reasons, *Griesau* fails to anticipate the Applicant’s invention as recited in Claim 1.

Huang recites a lighting control system that controls the operation of lamps and other electrical appliances. (*Abstract*). The system includes a master controller (element 100), zone controllers (elements 110), and slave units (elements 120). (*Abstract*). The master controller controls the zone controllers, the zone controllers control the slave units, and the slave units control the electrical appliances. (*Col. 6, Lines 19-23*). The master controller includes different configuration or “CONFIG” buttons, which store “operating levels” of the slave units. (*Col. 9, Lines 3-8*). The operating level of a slave unit identifies the brightness level of a lamp associated with the slave unit. (*Col. 8, Lines 21-28*).

First, *Huang* recites the use of a master controller that includes a processor (element 210). (*Figure 2A*). However, *Huang* recites that the master controller is coupled to the zone controllers and the slave units over a power line. (*Figure 1*). *Huang* lacks any mention that the processor communicates over a wireless connection. As a result, *Huang* fails to anticipate a “processor for providing commands to [a] plurality of lighting devices over [a] wireless connection” as recited in Claim 5.

Second, the Office Action asserts that *Huang* anticipates a “means for switching between an enumeration mode and [a] normal mode” at column 9, lines 5-15. (*Office Action, Page 3, Second paragraph*). However, the cited portion of *Huang* simply recites that the master controller includes different configuration buttons, which store brightness levels of the slave units. This portion of *Huang* lacks any mention that the configuration buttons are used to “associate” the slave units with the master controller. For example, this portion of *Huang* lacks any mention that the configuration buttons are used to associate a lamp with the master controller so it can be controlled or to disassociate the lamp from the master controller so it cannot be controlled. As a result, the cited portion of *Huang* fails to anticipate a “means for switching between an enumeration mode and [a] normal mode,” where the enumeration mode is utilized to “associate” devices with an apparatus as recited in Claim 5.

For these reasons, *Huang* fails to anticipate the Applicant’s invention as recited in Claim 5 (and its dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejections and full allowance of Claims 1 and 5-7.

II. REJECTIONS UNDER 35 U.S.C. § 103

The Office Action rejects Claims 2-4 under 35 U.S.C. § 103(a) as being unpatentable over *Griesau* in view of *Huang*. The Office Action rejects Claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* in view of U.S. Patent No. 5,847,955 to Mitchell et al. (“*Mitchell*”). The Office Action rejects Claim 11 under 35 U.S.C. § 103(a) as being

unpatentable over *Huang* and *Mitchell* in view of U.S. Patent No. 6,333,605 to Grouev et al. ("*Grouev*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second,

there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Claims 2-4 depend from Claim 1. As described above, Claim 1 is patentable. As a result, Claims 2-4 are patentable due to their dependence from an allowable base claim.

Regarding Claim 8, the Applicant first notes that the Office Action fails to identify the portion of *Mitchell* relied upon in rejecting Claim 8. The Applicant respectfully requests that the next Office Action identify the specific portions of *Mitchell* relied upon if the rejection of Claim 8 is maintained. Second, the Office Action asserts that *Huang* anticipates a “standardized command set” at column 6, lines 42-48. (*Office Action, Page 5, Last paragraph*). However, the cited portion of *Huang* simply recites that “password information, configuration information, and installation information” are stored in a memory. The Office Action fails to identify how any of this information anticipates a “standardized command set” for “facilitating command and control between a master device and plural slave lighting devices” as recited in Claim 8. Third, the Office Action does not explain why a “layer of software” is needed between the “password information, configuration information, and installation information” and a software application. In particular, the Office Action fails to explain why “customization” is needed to access and use the information in the memory. As a result, the Office Action does not establish that the proposed *Huang-Mitchell* combination discloses, teaches, or suggests all elements of Claim 8.

Regarding Claim 10, the Office Action asserts that *Huang* anticipates communicating a visual signal indicating the presence a slave device at column 27, lines 45-64. (*Office Action, Page 6, Third paragraph*). However, this portion of *Huang* lacks any mention of generating a “visual signal” at a slave device. In particular, this portion of *Huang* lacks any mention of “communicating a visual signal at each of the slave devices indicating the presence of each of said slave devices” as recited in Claim 10. *Mitchell* is not cited by the Office Action as disclosing, teaching, or suggesting these elements of Claim 10. As a result, the Office Action does not establish that the proposed *Huang-Mitchell* combination discloses, teaches, or suggests all elements of Claim 10.

For these reasons, the Office Action does not establish that the proposed *Huang-Mitchell* combination discloses, teaches, or suggests the Applicant’s invention as recited in Claims 8 and 10 (and its dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejections and full allowance of Claims 2-4 and 8-11.

III. NEW CLAIMS

The Applicant has added Claims 12-20. The Applicant respectfully asserts that no new matter had been added. The Applicant respectfully requests entry and allowance of Claims 12-20.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the

DOCKET NO. US010217 (PHIL06-10217)
SERIAL NO. 09/841,665
PATENT

application are in condition for allowance and respectfully requests an early allowance of such claims.

SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of all pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _____

Oct. 30, 2005



William A. Munck

Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: wmunck@davismunck.com